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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,814	07/05/2001	Francisco Javier Garcia-Ladona	0480/001210	1323
26474	7590	08/09/2004	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			JIANG, DONG	
			ART UNIT	PAPER NUMBER

1646

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action**Application No.**

09/869,814

Applicant(s)GARCIA-LADONA, FRANCISCO
JAVIER**Examiner**

Dong Jiang

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 29-32 and 34-36.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other: _____


LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 2. NOTE: the newly added claims 37 and 38 recite the limitation of animal models, which raises new issues that would require further consideration. Additionally, claims 29-32 and 34-36 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of records. Thus, the proposed amendment does not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 5. does NOT place the application in condition for allowance because: claims 29-32 and 34-36 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of records set forth in the previous Office Actions mailed on 5/22/03 and 2/25/04. Applicants argument filed on 7/15/04 has been fully considered, but is not deemed persuasive because the issue is not merely whether screening and testing binding partners for a 5-HT5-R is routine experimentation, rather, the main issue is that the declaration filed on 24 November 2003 provides one of such binding partner, the compound HK02-01, and no other binding partners for 5-HT5 receptor meeting the limitations of the claims were ever identified or particularly described in either the specification or the declaration. It is not predictable at all as to what compound would bind to the 5-HT5 receptor, and have the claimed therapeutic effect. As such, persons skilled in the art would not know how to make the invention commensurate in scope with the claims as they cannot envision the detailed chemical structure of the encompassed binding partners for 5-HT5 receptor.